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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
(100.003.5)

In re Application of: Martin R. Prince) Group Art Unit: 3737
Serial No: 10/648,167) Examiner: Jung, William C.
Filing Date: August 26, 2003)
Title: Method for Imaging an Artery Using a Magnetic Resonance Contrast Agent)

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REPLY OF MAY 18, 2006

Dear Sir:

This Reply seeks to place this application in condition for allowance. Based on the conditions and representations below, Applicant has addressed the Examiner's request and has provided a Terminal Disclaimer that addresses any additional/potential double patenting issues. It is believed that the Terminal Disclaimer complies fully with the relevant parts of 37 CFR 1.321. Applicant respectfully requests reconsideration of the application. Applicant submits that all of the pending claims present patentable subject matter. Accordingly, allowance of the claims is respectfully requested.

Paragraphs 1 and 2 of the Office Action

In paragraphs 1 and 2 of the Office Action of February 8, 2006 (hereinafter "the Office Action"), the Examiner requested, under 37 CFR 1.105, that Applicant disclose "all co-pending applications and related patents" and "identify the specific claims of those applications and/or patents which may present double patenting issues with the instant

claims." Applicant respectfully submits that the request is unclear and improper. For example, the request is unclear because it is not known what is meant by "all co-pending applications and related patents". Further, the request is improper because, for example, Applicant should not be expected to "identify the specific claims of those applications and/or patents which may present double patenting issues with the instant claims." (Office Action, page 2, Emphasis added)

In an effort to address the request and expedite the prosecution of the instant application, Applicant has provided a list of the co-pending applications and related patents of Applicant which may have a bearing on double patenting and/or obviousness type double patenting.¹

U.S. Patents

5,417,213	6,240,311
5,553,619	6,243,600
5,579,767	6,278,892
5,590,654	6,311,085
5,746,208	6,463,318
5,762,065	6,564,085
5,792,056	6,662,038
5,799,649	6,741,881
5,924,987	6,754,521
6,167,293	6,879,853
6,230,041	6,889,072

U.S. Patent Applications

10/808,693	(continuation of U.S. Patent 6,889,072)
10/809,835	(continuation of U.S. Patent 6,741,881)
11/003,101	(continuation of U.S. Patent 6,879,853)

¹ Although Applicant has attempted to provide an exhaustive list, due to the lack of clarity and subjective nature of the requested information, no inference or conclusion should be drawn that the list is exhaustive.

Commentary based on Personal Knowledge of the Examiner

Notably, to the extent understood, Applicant disagrees with the Examiner's characterization of the claims of the instant application in relation to U.S. Patent 5,417,213. As such, no inference or conclusion should be drawn that Applicant agrees, in any way, with the Examiner's characterization of the claims of the instant application, the claims of U.S. Patent 5,417,213, and/or the comparison of those claims. The Examiner appears to rely on his own personal knowledge to make the assertion that "claims 27-59 of application 10/648,167 differ from claims 1-66 of application 71,970 (now US Patent No. 5,417,213) in only the obvious variation of claiming the determination of arrival time of a test bolus in a region of interest by application center of k-space [sic], which is obvious in view of determining the rate of contrast agent infusion as claimed in US 5,417,213". As such, Applicant respectfully requests that he support his personal knowledge by affidavit in accordance with 37 CFR §104(d)(2). For example, the Examiner has identified no evidence for such propositions. Indeed, such statements are bear assertions without support. No inference or conclusion should be drawn that Applicant agrees, in any way, with such assertions.

Paragraph 3 of the Office Action – Double Patenting

Applicant believes that there is no basis for a rejection under 35 USC § 101. In this regard, it is respectfully submitted that the claims of the instant application are not substantively the same as the claims of any of the U.S. patents or U.S. Patent Applications identified above. (See, MPEP 804(II)(A), "'Same invention' means identical subject matter.").

Moreover, Applicant believes that there is no basis for an obviousness type double patenting rejection with respect to the claims of any co-pending application. However, to


address *any potential* concerns regarding nonstatutory double patenting with respect to U.S. Patents of the Applicant and to expedite the prosecution of the instant application, Applicant submits herewith a Terminal Disclaimer, executed by the attorney of record, directed to U.S. Patents 5,417,213, 5,553,619, 5,746,208, 5,762,065, 6,243,600, 6,278,892, 6,889,072, 5,579,767, 5,799,649, 6,230,041 and 6,662,038. Of the remaining U.S. patents and patent applications listed above, Applicant believes that the claims of those patents and applications do not present even a potential basis for an obviousness type double patenting rejection relative to the claims of the instant application.

While the Terminal Disclaimer is submitted to address *any potential* obviousness-type double patenting, no inference or conclusion should be drawn that Applicant agrees, in any way, that the claims of the instant application are obvious in view of the claims of U.S. Patents 5,417,213, 5,553,619, 5,746,208, 5,762,065, 6,243,600, 6,278,892, 6,889,072, 5,579,767, 5,799,649, 6,230,041 and 6,662,038. It is believed that the Terminal Disclaimer complies fully with the relevant parts of 37 CFR 1.321.

CONCLUSION

Applicant respectfully requests reconsideration of the instant application. Applicant submits that all of the pending claims present patentable subject matter. Moreover, Applicant submits that the Terminal Disclaimer filed herewith obviate any potential double patenting rejections. Accordingly, allowance of the claims is respectfully requested.

Respectfully submitted,



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Date: May 18, 2006